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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,475	02/10/2004	James B. Bingham	TWAV:004USD3	1382
7590 08/10/2007				
David D. Bahler, Esq. FULBRIGHT & JAWORSKI L.L.P. Suite 2400 600 Congress Avenue Austin, TX 78701			EXAMINER HOLMES, REX R	
			ART UNIT 3762	PAPER NUMBER
			MAIL DATE 08/10/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/775,475

Applicant(s)

BINGHAM ET AL.

Examiner

Rex Holmes

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 23-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 5/21/07 have been fully considered but they are not persuasive. The Applicant incorrectly cites the Examiner on page 7, lines 12-13. The Applicant believes that the electrodes are of Kanare are only operable to heat the injured area. However, Kanare discloses that the electrodes provide electrical stimulation, and further that a heat pack provides the heat (Col. 5, ll. 35-45). Thus, Kanare in view of Olsen disclose each step of the claimed method.
2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kanare discloses an electrical stimulation system that also includes a pouch for a heating/cooling pack. Kanare does not specifically disclose what kind of heating/cooling pack is to be used. Olsen discloses a RF diathermy heating device that can be incorporated into a garment. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the electrical heating device of Olsen into the stimulation/heating system of Kanare since it is known in the art that RF warming is a suitable and popular way to warm tissue.

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3. Applicant's arguments and amendments, see arguments/amendments, filed 5/21/07, with respect to 35 USC 112 rejections have been fully considered and are persuasive. The rejections of claims 24-27 under 35 USC 112 have been withdrawn.

***Information Disclosure Statement***

4. The information disclosure statement (IDS) submitted on 4/23/04 is being considered by the examiner, as the prior art was included with prior application 09/616,769.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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7. Claims 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanare et al. (U.S. Pat. 5,336,255 hereinafter "Kanare") in further view of Olsen (U.S. Pat. 5,160,828).

8. Regarding claims 23-24, Kanare discloses an electrical stimulation heat/cool pack made of a flexible fabric that contains multiple electrodes that can be easily fastened to a patient's injured area (Col. 1, ll. 13-20; Col. 2, ll. 63-68 & Col. 3, ll. 1-2). Kanare further discloses that the electrical stimulator can heat the injured area as it is stimulating and increasing blood flow (Col. 1, ll. 4-20). Kanare fails to disclose that the heating part of the stimulation pack is a RF diathermy device. However, Olsen discloses a RF warming device that is incorporated into wearable garments. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the electrical stimulation heat pack as taught by Kanare, with RF warming as taught by Olsen, since it is known in the art that RF warming is a suitable and popular way to warm tissue.

In regards to claims 25-27, Kanare in view of Olsen discloses the claimed invention except for the use of a RF diathermy/stimulation device for the treatment of diabetic neuropathy, carpal tunnel syndrome or Raynaud's disease. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Kanare in view of Olsen, with the treatments of diabetic neuropathy, carpal tunnel and Raynaud's disease since it was known in the art that warming and muscle stimulation is used to provide treatment for diabetic neuropathy, carpal tunnel and Raynaud's disease.

In regards to claims 28-29, Kanare in view of Olsen disclose the claimed invention except for whether the stimulation step or the heating step comes first. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Kanare in view of Olsen, with either heating or stimulation first since it was known in the art that both stimulation and RF heating are electrically controlled and it would have been obvious to one having ordinary skill in the art to use a controller to either turn on the heating/stimulation first and the stimulation/heating second as a person with ordinary skill has good reason to pursue the known options within his or her technical grasp.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Salansky et al. (U.S. Pat. 6,063,108) discloses the use of heat to treat neuropathy and carpal tunnel. Macher et al. (U.S. Pat. 6,066,164) discloses the use of heat to treat Raynaud's disease. Browner (U.S. Pat. 2,841,135) discloses a garment for stimulation and heating.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rex Holmes whose telephone number is 571-272-8827. The examiner can normally be reached on M-F 8:00 - 5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Rex Holmes  
Examiner  
Art Unit 3762



George Evanisko  
Primary Examiner  
Art Unit 3762

9/5/17